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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/719,080	11/21/2003	Michael Graupe	USAV2001/0082-US-CNT	2253
46137 7590 12/07/2007 SYNNESTVEDT & LECHNER LLP 2600 ARAMARK TOWER 1101 MARKET STREET PHILADELPHIA, PA 19107-2950			EXAMINER ANDERSON, REBECCA L	
			ART UNIT 1626	PAPER NUMBER
			MAIL DATE 12/07/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/719,080

Applicant(s)

GRAUPE ET AL.

Examiner

Rebecca L. Anderson

Art Unit

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,8-10,14,17 and 18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,8-10 and 17 is/are rejected.
- 7) ☒ Claim(s) 9, 10, 14 and 18 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

Claims 1, 8-10, 14, 17 and 18 are currently pending in the instant application.

Claims 1, 8-10 and 17 are rejected. Claims 9, 10, 14 and 18 are objected.

#### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 30 October 2007 has been entered.

#### ***Response to Amendment***

Applicants' amendment filed 30 October 2007 has overcome the objection to claims 1, 8, 14, 17 and 18. Claims 9 and 10 still contain non-elected subject matter as discussed below, therefore the objection is maintained from claims 9 and 10. Applicants' amendment to claim 14 has overcome the 35 USC 112 1st paragraph rejection.

#### ***Claim Objections***

Claims 9 and 10 are objected to as containing non-elected subject matter. Specifically, various values for R3 in claim 9 are outside the scope of the elected invention. For example, various values of R3 in claim 9 are not within the elected invention, see for example, 2-(pyridine-3-sulfonyl)-ethyl which does not have R14 as cycloalkyl, aryl or bicycloaryl containing and prop-2-ene-1-sulfonyl-methyl which does

not have R14 as cycloalkyl, aryl or bicycloaryl containing, etc. Additionally, claim 9 and claim 10 both include R3 as X5S(O)2R14, however, R3 in the elected invention is C(R6)(R6)X6 wherein X6 is X5S(O)2R14. This objection can be overcome by deleting the non-elected subject matter from claims 9 and 10.

Claim 14 is objected to as being dependent upon a rejected base claim, but would appear allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 18 is objected to as being dependent upon a cancelled base claim. It is suggested that claim 18 be cancelled or the dependency be changed to that of a pending claim.

Claims 9 and 10 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Specifically, claims 9 and 10 include subject matter not found in parent claim 1. For example, various values of R3 in claim 9 do not find support in parent claim 1, see for example, 2-(pyridine-3-sulfonyl)-ethyl which does not have R14 as cycloalkyl, aryl or bicycloaryl containing and prop-2-ene-1-sulfonyl-methyl which does not have R14 as cycloalkyl, aryl or bicycloaryl containing, etc. Additionally, claim 9 and claim 10 both include R3 as X5S(O)2R14, however, R3 in claim 1 is C(R6)(R6)X6 wherein X6 is X5S(O)2R14 and R3 in claim 8 is CH2X6 wherein X6 is X5S(O)2R14. This objection of claims 9 and 10

can be overcome by amending the claims to include only the elected subject matter present in claims 1 and 8.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 8-10 and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, claim 1 states "wherein within R5, X3 or X4 any alicyclic or aromatic ring system...". This statement renders the claims indefinite as there is insufficient antecedent basis for within R5 and X4. Additionally, there is not just any alicyclic or aromatic ring system in X3 as X3 is benzooxazol-2-ylcarbonyl. This rejection can be overcome by amending claim 1 to exclude the references to R5 and X4 and amending the generic ring systems of within X3 to be limited to the actual ring of R3.

**Conclusion**

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Rebecca L. Anderson whose telephone number is (571) 272-0696. Mrs. Anderson can normally be reached Monday through Friday from 6:00am until 2:30pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Mr. Joseph K. McKane, can be reached at (571) 272-0699.

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The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*/Rebecca Anderson/  
Primary Examiner, AU 1626*

4 December 2007

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Rebecca Anderson  
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